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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,520	12/07/2000	John Roderick Morrison	14390	1130

7590

04/01/2002

Attn: Leopold Presser, Esq.
Scully, Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

BAKER, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 04/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,520

Applicant(s)

MORRISON ET AL.

Examiner

Anne Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *detailed action*.

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DETAILED ACTION

Claims 1-44 are pending in the instant application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, 41, and 42, drawn to a neural stem cell composition and a method of culturing neural stem cells, classified in class 435, subclass 368.
- II. Claim 21, drawn to a method of preparing a genetically modified animal by introducing a neural stem cell into an oocyte, classified in class 800, subclass 21.
- III. Claims 22-32, drawn to a cloned animal and a method of producing a cloned animal by nuclear transfer, classified in class 800, subclass 24.
- IV. Claims 33-40, drawn to a cell culture medium, classified in class 435, subclass 325.
- V. Claims 43 and 44, drawn to a method of treating a neurological disorder, classified in class 424, subclass 93.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-V are patentably distinct, one from the other, because the inventions are drawn to distinct compositions and materially different methods. The neural stem cell composition of the invention of Group I is structurally, chemically, biologically, and functionally distinct from the

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genetically modified animal of the invention of Group II, the cloned animal of the invention of Group III, and the cell culture medium of the invention of Group IV. While the cell culture medium of the invention of Group IV can be used in the method of the invention of Group I (the method of culturing neural stem cells), its use is not limited to the culturing of neural stem cells, as it can also be used to culture other cell types. The methods of the inventions of Groups I and Groups II-V are distinct methods that require different starting materials, different modes of operation, and produce different effects. Thus, the methods and compositions of the invention of Group I are patentably distinct from the methods and compositions of the inventions of Groups II-V.

Inventions II and III-V are patentably distinct, one from the other, because the inventions are drawn to materially different methods that require different starting materials, different modes of operation, and produce different effects. The compositions of the inventions of Groups III-V are not required for and cannot be used in the method of the invention of Group II. The method of the invention of Group II requires as starting materials a neural stem cell and an oocyte, whereas the method of the invention of Group III requires a donor cell nucleus and an oocyte or embryo. The methods are not disclosed as being used together. The method of the invention of Group V involves treating a neurological disorder in a patient, whereas the method of the invention of Group II involves the production of a genetically modified animal. These methods are unrelated. Thus, the method of the invention of Group II is patentably distinct from the methods and compositions of the inventions of Groups III-V.

Inventions III and IV-V are patentably distinct, one from the other, because the inventions are drawn to materially different methods that require different starting materials, different modes of operation, and produce different effects. The cloned animal of the invention of Group III is structurally,

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chemically, biologically, and functionally distinct from the cell culture medium of the invention of Group IV. Furthermore, the cloned animal of the invention of Group III is not required for and cannot be used in the method of the invention of Group V (the method of treating a neurological disorder). Thus, the composition of the invention of Group III is patentably distinct from the methods and compositions of the inventions of Groups IV-V.

Inventions IV and V are patentably distinct because the inventions are drawn to compositions and methods that are unrelated. The cell culture medium of the invention of Group IV is not required for and cannot be used for carrying out the method of the invention of Group V. Thus, the composition of the invention of Group IV is patentably distinct from the method of the invention of Group V.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the separate inventions are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Baker whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 10:00 AM to 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Dianiece Jacobs, whose telephone number is (703) 305-3388.

Anne-Marie Baker, Ph.D.

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER